

**Notice of Allowability**

Application No.

09/808,898

Examiner

Samuel W. Liu

Applicant(s)

BRYAN ET AL.

Art Unit

1653

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 3/17/05.
2. ☒ The allowed claim(s) is/are 1-13,22,38-50,57 and 58.
3. ☒ The drawings filed on 16 April 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
  1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 9/13/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date 3/28/05
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

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### **DETAILED ACTION**

The terminal disclaimer filed on 3/17/2005 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Pat. No. 6232107 have been reviewed and are accepted.

Applicants' amendments filed 3/17/05 (after final) which amends claims 3, 10, 11, 45, 47 and 50 has been entered. The references of the IDS filed 9/13/04 have been considered by Examiner. The pending claims 1-77 are examined in this Office action.

### **EXAMINER'S AMENDMENT**

An Examiner's Amendment to the record appears below. Should the change and/or additions be unacceptable to Applicant, an amendment may be filed as provided by 37 C.F.R. § 1.312. To ensure consideration of such an amendment, it MUST be submitted no latter than payment of the Issue Fee.

Authorization for this Examiner's Amendment was given in a personal interview with Applicants' representative Lara A. Northrop on March 28, 2005. Applicant agrees to the Examiner proposed amendment to claims 3, 10, 22, 38, 41, 45 and 47, and cancel claims 14-21, 23-37, 51-56 and 59-77 without prejudice (see below).

#### **Amendments to the claim:**

The pending claims 3, 10, 22, 38, 41, 45 and 47 are amended (including cancellation of claims 14-21, 23-37, 51-56 and 59-77) as follows. Please replace the previous claims with the claims shown below.

Claim 3 (*Twice amended*): In item (a), change "SEQ ID NOS:23-25" to "SEQ ID NOs: 23-25".

Claim 10 (*Twice amended*): Change "a cloning site for the introduction of nucleic acid" to "a cloning site for the introduction of the nucleic acid molecule"; and after "wherein the nucleic acid" add "molecule".

Delete claims 14-21.

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Claim 22 (*Amended*): Change “the nucleic acid” to “nucleic acid molecule”.

Delete claims 23-37.

Claim 38 (*Amended*): Change “a nucleotide sequence of claim 1” to “the nucleotide sequence of claim 1”.

Claim 41 (*Amended*): change “high stringency” to “the conduction of claim 1”.

Claim 45 (*Twice amended*): After “a promoter element” delete “;” and add “and”.

Claim 47 (*Twice amended*): Change “fluorescent protein” to GFP”.

Delete claims 51-56 and claims 59-77.

The following is an **Examiner's Statement of Reasons for Allowance**: In light of that the applicants have filed the terminal disclaimer to overcome the obviousness-type double patenting rejection, and that the prior art does not teach or suggest the claimed polynucleotide encoding the *Renilla reniformis* green fluorescent protein, claims 1-13, 22, 38-50 and 57-58 are allowable over the art of record.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Samuel Wei Liu, Ph.D. whose telephone number is (703) 306-3483. The Examiner can normally be reached daily except alternate Fridays from 8:30 A.M. to 5:30 P.M. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christopher Low, can be reached at (703) 308-2329. The official fax number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.



Samuel W. Liu, Ph.D.

March 28, 2005



KAREN COCHRANE CARLSON, PH.D.  
PRIMARY EXAMINER